



LMC: 5/23/07 6884-65576-01 P03-0006

Attorney Reference Number 6884-65576-01
PATENT

AS
TFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John L. Klocke and Linlin Chen

Application No. 10/688,420

Filed: October 16, 2003

Confirmation No. 2239

For: ELECTROPLATING COMPOSITIONS
AND METHODS FOR
ELECTROPLATING

Examiner: Edna Wong

Art Unit: 1753

Attorney Reference No. 6884-65576-01

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF - PATENTS, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 on the date shown below.

Attorney or Agent
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TRANSMITTAL LETTER

Enclosed for filing in the application referenced above are the following:

- ☒ Response to Non-Compliant Appeal Brief
- ☒ The Director is hereby authorized to charge any additional fees that may be required, or credit over-payment, to Deposit Account No. 02-4550. A copy of this sheet is enclosed.
- ☒ Please return the enclosed postcard to confirm that the items listed above have been received.

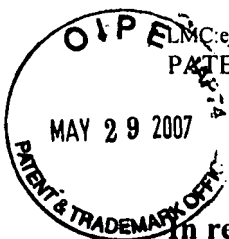
Respectfully submitted,

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RESPONSE TO NON-COMPLIANT APPEAL BRIEF

This is in response to the Notification of Non-Compliant Appeal Brief mail date May 3, 2007.

This Notification of Non-Compliant Appeal Brief has the same objection to the Appeal Brief as was made in a prior Notification of Non-Compliant Appeal Brief mailed by the U.S. PTO on January 18, 2007. The issue was already resolved with the Patent Appeal Center/PTO. A Response and Supplemental Summary of the Claimed Subject Matter was filed on February 16, 2007, and the matter was indicated as resolved. Since then Applicants' Appeal Brief has been forwarded to the Board of Patent Appeals and Interferences (on February 21, 2007).

More specifically as to the resolution of the issue, on January 22, 2007, Applicants' counsel spoke to Patent Appeal Center Specialist Bridget Monroe in regard to the subject Notification. Counsel and Ms. Monroe discussed how the Summary previously provided in the Brief already met the rules as set forth in the C.F.R., and Ms. Monroe stated that a statement to this affect was sufficient to overcome the objection and comply with the Rules. Nonetheless, to aid the Board in its review of the present patent application claims and the pending rejections of the same, Applicants added more claim references to the Summary to further show where

claimed features of the invention as recited in the independent claims are mentioned in the Summary¹ (to further map the claims).

It is important to note that 37 C.F.R. § 41.37(c)(1)(v) does not require even as much "mapping" as Applicants have already done in its Appeal Brief Summary.

C.F.R. § 41.37(c)(1)(v) recites:

Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Emphasis added.

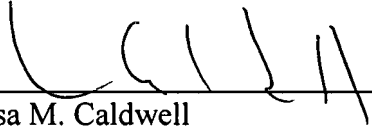
None of the claims in the present application are § 112, paragraph 6 claims. Thus, the only issue for § 41.37(c)(1)(v) as applied to the present brief is that Applicants provide a precise explanation of the subject matter recited in each independent claim, referring to the specification by page and line number. This requirement has been more than met by the Summaries provided. Thus, the Appeal Brief complies with 37 CFR § 41.37(c)(1)(v).

Respectfully submitted,

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¹ It should be noted that although the Summary includes citations to particular page and line numbers of the specification where features of the cited claims are discussed, those may not be the only place within the specification such features are discussed.